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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,161	06/26/2001	Michael R. Ohran	14113.3.2.2	4716
7590	03/08/2007		EXAMINER	
R. Burns Israelsen WORKMAN, NYDEGGER & SEELEY 1000 Eagle Gate Tower 60 East South Temple Salt Lake City, UT 84111			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3694	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/08/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/892,161	OHRAN, MICHAEL R.	
	Examiner	Art Unit	
	Ella Colbert	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 December 2006.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-7 and 9-39 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-7 and 9-39 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/11/06</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

1. Claims 1-7 and 9-39 are pending. Claims 1, 7, 9, 16, and 25 have been amended in this communication filed 12/12/06 entered as Response After Non-Final Action.
2. The IDS filed 9/11/06 has been considered and entered.

### ***Oath/Declaration***

3. It is noted that the related applications listed on page 2 of the Specification under the section "Related Applications" do not have the benefit claimed of earlier filed since application serial no. 09/271,585 is a continuation of application no. 08/848,139 now U.S. Patent No. 5,978,565. Applicant is only claiming benefit to application 09/271,585 and the application and patented application are incorporated by reference in the present application. Does Applicant not want to claim the benefit of the patented application?

### ***Claim Objections***

3. Claims 3, 7, 14, and 39 are objected to because of the following informalities: Claim 3 line 3, recites "the write request using infrastructure of the network, wherein the infrastructure is used". This line would be better recited "the write request using the infrastructure of the network, wherein the infrastructure is used". Claim 7 recites "... further comprising using the a policing protocol, prior to executing the write request at". This line would be better recited as "... further comprising using the policing protocol, prior to executing the write request at". Claim 39 has a similar problem. Claim 14 has the "and" omitted after "device" and before "executing".

Claim 16 is in the improper format for a method claim. Line 9 in the body of the claim recites "while the first server has write access priority ...". This line should recite in lines 8 and 9 "mass storage device and while the first server has write access priority to the portion of the first".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3, 9, 14, 16, 18- 20, 22, 23, 26 –28, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, 9, 14, 16, 18-20, 22, 23, 26 –28, and 38 contain a clause of intended use in the claims which renders the claims indefinite. Specifically, claim 1 lines 13 -15 recites in the body of the claim recites "server, thereby mirroring the data at the second mass storage device, wherein the data is stored in a virtual ...".

Claims 3, 9, 14, 16, 18-20, 22, 23, 26-28, and 38 have a similar problem with the claim limitations.

The Examiner considers these limitations to only recite what is expected to happen, a desired result, or an intended use. The MPEP discusses a type of limitation in reference to "whereby" clauses and "wherein" clauses. MPEP § 2111.04 states:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim

to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

While a "thereby" clause is not enumerated in the list of examples above, the MPEP expressly states that the list is not exhaustive. In the instant case, the "thereby" clause has the same effect as the above phrases, in that the claim is ambiguous as to whether in claim 1 the data is mirrored at the second mass storage device, "wherein the data is stored in a virtual shared storage node from the standpoint of the first server and the second server". Claims 3, 9, 14, 18-20, 22, 23, 26-28, and 38 raise the same question with the usage of "thereby" clauses and "wherein" clauses.

The MPEP also states in 2172.01:

... a claim which fails to interrelate elements as defined by applicant(s) in the specification may be rejected under 35 USC 112, second paragraph, for failure to point out and distinctly claim the invention.

Claim 16, line 16 in the body of the claim recites "..., thereby enabling both the first server and". The usage of the term "enabling" is not a positive recitation. This claim limitation would be better recited as "..., so that the first server and the second server can have access to the data". Claims 20, 23, and 26 have a similar problem.

Claim 20 also recites "enables" in the preamble. Claim 23 recites "a third mirror engine, wherein the third mirror engine is capable of". This claim limitation is not a positive claim recitation. The claim limitation would be better recited as "a third mirror engine, the third mirror engine can mirror, to the first mass storage device ...".

Claim 26 contains a conditional statement. It is unclear what happens next if the write request does not have priority over any other write request that is pending for the particular portion of the first mass storage device and the second mass storage device, ... and if the policing protocol does not determine that the write request does have priority".

Claims 2, 3, 8-15, 17-27, 29, 30, and 35-48 are also rejected because they depend from a rejected base claim.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. § 112: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9,12, and 13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular,

A. Claim 9 is not sufficiently precise due to the combining of two separate statutory classes of invention in a single claim. The preamble of the claim refers to a method (ex. preamble of claim 9), the body of the claim discusses the specifics of the means plus function, and subsequently the claim then deals with the specifics of a method (the steps) receiving the write request, determining the first server has write access, writing the data, and transmitting a copy of the write request (see above rejection of claims

under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

B. Claims 12 and 13 are rejected as being dependent on claim 30 as discussed above.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

9. Claims 9, 12, and 13 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a method (ex. preamble of claim 9), the body of the claim discusses the specifics of the means plus function, and subsequently the claim then deals with the specifics of a method (the steps) receiving the write request, determining the first server has write access, writing the data, and transmitting a copy of the write request (see above rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is

precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

**Inquiries**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

March 3, 2007



ELLA COLBERT  
PRIMARY EXAMINER